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2173.05(p) Claim Directed to Product-By- Process or Product and Process - 2100 Patentability

2173.05(p) Claim Directed to Product-By- Process or Product and Process

There are many situations where claims are permissively drafted to include a reference to more than one statutory class of invention.

I. PRODUCT-BY-PROCESS

A product-by-process claim, which is a product claim that defines the claimed product in terms of the process by which it is made, is proper. *In re Luck*, 476 F.2d 650, 177 USPQ 523 (CCPA 1973); *In re Pilkington*, 411 F.2d 1345, 162 USPQ 145 (CCPA 1969); *In re Stepan*, 394 F.2d 1013, 156 USPQ 143 (CCPA 1967). A claim to a device, apparatus, manufacture, or composition of matter may contain a reference to the process in which it is intended to be used without being objectionable under 35 U.S.C. 112, second paragraph, so long as it is clear that the claim is directed to the product and not the process.

An applicant may present claims of varying scope even if it is necessary to describe the claimed product in product-by-process terms. *Ex parte Pantzer*, 176 USPQ 141 (Bd. App. 1972).

II. PRODUCT AND PROCESS IN THE SAME CLAIM

A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite

under **35 U.S.C. 112**, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly rejected under **35 U.S.C. 112**, second paragraph.

Such claims should also be rejected under **35 U.S.C. 101** based on the theory that the claim is directed to neither a "process" nor a "machine," but rather embraces or overlaps two different statutory classes of invention set forth in **35 U.S.C. 101** which is drafted so as to set forth the statutory classes of invention in the alternative only. *Id.* at 1551.

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